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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,918	01/30/2004	Thomas Patrick Nolan	146712003900	3978

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EXAMINER

BERNATZ, KEVIN M

ART UNIT PAPER NUMBER

1773

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,918

Applicant(s)

NOLAN, THOMAS PATRICK

Examiner

Kevin M. Bernatz

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-22 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Response to Amendment

1. Amendments to the specification and claims 1, 3 and 8, cancellation of claim 10, and addition of new claims 21 and 22, filed on June 20, 2006, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. Claims 1, 2, 5 – 9 and 21 are rejected under 35 U.S.C. 102(a), (b), and/or (e) as being anticipated by Kikitsu et al. (U.S. Patent No. 5,652,054) for the reasons of record as set forth in Paragraph No. 7 of the Office Action mailed on March 20, 2006.

Regarding the amended language of claim 1, Kikitsu et al. disclose a Co-containing matrix (*Figures and col. 11, line 51 bridging col. 12, line 6*), and said ferromagnetic portion comprising less than 5 atomic percent Cr (*e.g. Example 1 has 0 at% Cr*).

Regarding new claim 21, Kikitsu et al. disclose CoPt ferromagnetic portions (*example 1*).

Claim Rejections - 35 USC § 103

4. Claims 3, 4 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikitsu et al. as applied above, and further in view of Takizawa et al. (U.S. Patent App. No. 2002/0095767 A1) for the reasons of record as set forth in Paragraph No. 10 of the Office Action mailed on March 20, 2006.

Regarding new claim 22, Kikitsu et al. disclose that the same elements added to the magnetic grains for improved characteristics of the magnetic grain (i.e. Pt) can be added to the matrix, provided that the amount added to the matrix is significantly less than that added to the grain (*Figures 5 – 8 and relevant disclosure thereto; and col. 5, line 58 bridging col. 6, line 6*).

5. Claims 2, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikitsu et al. as applied above, and further in view of Fullerton et al. (U.S. Patent No. 6,440,589 B1) for the reasons of record as set forth in Paragraph No. 11 of the Office Action mailed on March 20, 2006.

Response to Arguments

6. **The rejection of claims 1 – 9 previously under 35 U.S.C § 102(e) and/or 103(a) – Kikitsu et al. ('620), alone or in view of various references**

The above noted rejection has been withdrawn because applicant(s) amendment(s) have set forth new limitations (e.g. a Co-containing matrix) no longer anticipated, nor rendered obvious, by the above noted rejection.

7. The rejection of claims 1 – 9, 21 and 22 under 35 U.S.C § 102(a), (b) and/or (e) and/or 103(a) – Kikitsu et al. ('054), alone or in view of various references

Applicant(s) argue(s) that Kikitsu et al. ('054) fail to disclose “said portion comprises less than 5 atomic percent Cr” (*page 6 of response*). The Examiner respectfully disagrees.

The Examiner notes that the present claims read on 0 at% Cr, which is explicitly disclosed by the Kikitsu et al. invention.

Regarding applicants' argument that Kikitsu et al. “explicitly states that there is no Co or Pt in the continuous non-magnetic matrix” (*pages 6 – 7 of response*), the Examiner reminds applicants that the rejection is based on the entire reference(s) and not just a piece meal analysis of the cited reference(s). In the instant case, Kikitsu et al. explicitly teach that the matrix need not have 0 at% Co or 0 at% Pt (or any element added to the magnetic portion for improving the magnetic characteristics) (*col. 5, line 58 bridging col. 6, line 6 and col. 11, line 51 bridging col. 12, line 6*). The fact that one specific embodiment may not have any Co or Pt in the non-magnetic matrix does not negate the general teaching that is *explicitly* taught in the Kikitsu et al. reference.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

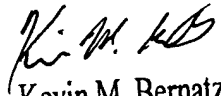
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB
August 23, 2006


Kevin M. Bernatz, PhD
Primary Examiner